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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,068	08/22/2003	Louis C. Argenta	0101 P02977US1	9699

110 7590 12/21/2005

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EXAMINER

PHILOGENE, PEDRO

ART UNIT PAPER NUMBER

3733

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/227,161. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is clear that all the elements of claims 1-13 of the '161 application, are to be found in claims 1-13 of '161 application. The difference between these two sets of claims lies in the fact that the claims of the '068 application includes many more elements and is thus much more specific. Thus the invention of claims 1-13 of the '161 application is in effect a "species of the "generic" invention of claims 1-13 of the '068 application. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993). Since, claims 1-13 of the '068 application are anticipated by claims 1-13 of the '161 application, they are not patentably distinct from claims 1-13 of the '161 application.

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Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45,96-103, 113-121 of copending Application No. 10/161,076 in view of Dunn et al. (5,717,030). Dunn et al teach a system that can be implanted anywhere in the body including bone, as best seen in column 5, lines 19-22. The system can be biodegradable and the active ingredient can include bone growth agents. Therefore, Dunn teach a bone substitute material that is bioabsorbable to promote bone growth. It would have been obvious to one having ordinary skill in the art to modify the copending claims to include bone substitute material at the wound to repair bone tissue. The copending claims already recite the treatment of repairing bone tissue. Dunn et al teach the details of the material that would provide the recited function.

Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-14,16-19,23-30,32,33,37-50,52-56,84-132 of copending Application No. 09/863,234 in view of Dunn et al. (5,717,030). Dunn et al teach a system that can be implanted anywhere in the body including bone, as best seen in column 5, lines 19-22. The system can be biodegradable and the active ingredient can include bone growth agents. Therefore, Dunn teach a bone substitute material that is bioabsorbable to promote bone growth. It would have been obvious to one having ordinary skill in the art to modify the copending claims to include bone substitute material at the wound to repair bone tissue. The copending claims already recite the treatment of repairing bone tissue. Dunn et al teach the details of the material that would provide the recited function.

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Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 38-41,43-46,71-80,83-86 of copending Application No. 09/026,353 in view of Dunn et al. (5,717,030). Dunn et al teach a system that can be implanted anywhere in the body including bone, as best seen in column 5, lines 19-22. The system can be biodegradable and the active ingredient can include bone growth agents. Therefore, Dunn teach a bone substitute material that is bioabsorbable to promote bone growth. It would have been obvious to one having ordinary skill in the art to modify the copending claims to include bone substitute material at the wound to repair bone tissue. The copending claims already recite the treatment of repairing bone tissue. Dunn et al teach the details of the material that would provide the recited function.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coffey (2001/0043943) in view of Dunn et al. (5,717,030).

With respect to claims 1-13, Coffey discloses a method for administering, applying, facilitating, treating and healing a reduced pressure treatment to a damaged tissue including a cover, a seal, open cell polymer foam, screen, vacuum suction port.

It is noted that Coffey teaches a substitute material to stabilize a wide variety of anatomical defects but doesn't recite use for hard tissue such as bone. However, in a similar art, Dunn et al evidences the use of a substitute that can be used any where in the body including hard tissue such as bone.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Coffey to use the substitute material for bone as taught by Dunn as an obvious equivalent alternative treatment as suggested by the prior art.

***Response to Arguments***

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Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

2001/0043943	11-2001	Coffey
5,717,030	02-1998	Dunn et al.

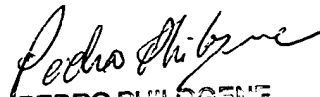
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pedro Philogene  
December 14, 2005



FEDRO PHILOGENE  
PRIMARY EXAMINER